

Docket No.: MML-003
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jerome S. Golden

Application No.: 09/541,197

Confirmation No.: 4910

Filed: April 3, 2000

Art Unit: 3691

For: SYSTEM AND METHOD FOR PROVIDING
SECURE RETIREMENT BENEFITS VIA A
CONVERSION PROCESS

Examiner: S. E. Chencinski

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This communication is responsive to the Notification of Non-Compliant Appeal Brief mailed August 25, 2008. Appellant filed an original Appeal Brief on May 20, 2008. On May 29, 2008, the Office mailed a Notification of Non-Compliant Appeal Brief which asserted that the summary of claimed subject matter in the Brief failed to comply with 37 C.F.R. 41.37(c)(1)(v). Appellant filed a paper providing a compliant summary of the claimed subject matter on June 25, 2008. The Office recently mailed a second Notification of Non-Compliant Appeal Brief which asserts: "The BPAI requires that an amended Appeal Brief be submitted in its entirety." Appellants note that this requirement directly contradicts the first Notification of Non-Compliant Appeal Brief which stated: "The entire brief is not required only the section found defective." Further, the MANUAL OF PATENT EXAMINING PROCEDURE sets forth:

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR (c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary

of the claimed matter as required by 37 CFR 41.37(e)(1)(v) will suffice.

M.P.E.P. § 1205.03 (8th Ed., Rev. 3, 2005). Appellant, thus, questions the propriety of the requirement made in the recent Notice. Notwithstanding, Appellant submits concurrently herewith an Amended Appeal Brief submitted in its entirety including the summary of the claimed subject matter from the Appellant's June 25, 2008, filing.

Appellant respectfully submits that the Amended Appeal Brief submitted herewith fully complies with 37 C.F.R. § 41.37(e). Appellant requests that the Amended Appeal Brief be considered by the Examiner. Any fees that may be due with this response may be charged to the undersigned's deposit account 50-4494.

Dated: August 27, 2008

Respectfully submitted,

By: /Carl Benson/

Carl Benson
Registration No.: 38,378
GOODWIN PROCTER LLP
901 New York Avenue, NW
Washington, DC 20001
(202) 346-4000
Attorney for Appellant